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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,577	07/29/2003	Augusto Rodriguez	005242.00059	4091
22907	7590	06/23/2005	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			CORDRAY, DENNIS R	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,577

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Dennis Cordray

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to composition, classified in class 106, subclass 206.1.
 - II. Claims 13-24, drawn to a process of use, classified in class 162, subclass 135.
2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, such as the sizing of glass filaments.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. This application further contains claims directed to the following patentably distinct species of the claimed invention:
 - A a composition comprising a film-forming binder, an anionic polymer and a cationic polymer

Art Unit: 1731

- B a composition comprising a cationic polymer grafted onto a starch and an anionic polymer
- C a composition comprising an anionic polymer grafted onto a starch and a cationic polymer.

5. This application further contains claims directed to the following patentably distinct subspecies of the claimed invention:

- 1 for anionic polymer - a hydrolyzed copolymer of styrene-maleic anhydride, a copolymer of styrene-maleic acid, a styrene-acrylic acid copolymer, a styrene-methacrylic acid copolymer, a styrene-fumaric acid copolymer, a styrene-acrylonitrile-acrylic acid copolymer, a styrene-butyl acrylate-acrylic acid copolymer, a copolymer of styrene-acrylic ester dispersed in a copolymer of styrene-maleic acid, an anionic polymer latex having sulfonic or carboxylic moieties.
- 2 for cationic polymer - a polyamine; a polyethylene imine, a styrene-maleic anhydride copolymer imide quaternary ammonium salt, a polyamidoamine-epichlorohydrin resin, a dialkylamine-epichlorohydrin resin, a homo- or copolymer of diallyldimethyl-ammonium chloride, a homo- or copolymer of a vinyl amine, a homo- or copolymer of an acrylamide, a homo- or copolymer of a methacrylamide, a homo- or copolymer of an acrylate, a homo- or copolymer of a methacrylate.

Art Unit: 1731

- 3 if species A is elected, for the film-forming binder – the species revealed in the disclosure (a starch, a cellulosic polymer, dextran, collagen, gelatin, poly(vinyl alcohol), poly(vinyl phosphate), poly(vinyl pyrrolidone), a vinyl-pyrrolidone-vinyl acetate copolymer, a vinyl acetate-acrylic acid copolymer, a vinyl alcohol-vinyl acetate copolymer, a vinyl pyrrolidone-styrene copolymer, a poly(vinylamine), a poly(acrylic acid-co-methacrylate), a poly(vinyl-co-acrylate), sodium alginate, potassium alginate, carboxymethyl cellulose, hydroxyethyl cellulose).
6. Applicant is required under 35 U.S.C. 121 to elect a single claimed species of the invention, a single disclosed subspecies for the film-forming binder, a single claimed subspecies of the anionic polymer and a single claimed subspecies of the cationic polymer for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.
7. Applicant is advised that a reply to these requirements must include an identification of the species and subspecies that are elected consonant with these requirements, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

Art Unit: 1731

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DRC



PETER CHIN
PRIMARY EXAMINER